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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,115	01/07/2004	Timothy D. Hey	DAS-104XC1	8974

23557 7590 07/08/2005

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EXAMINER

CARLSON, KAREN C

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,115

Applicant(s)

HEY ET AL.

Examiner

Karen Cochran Carlson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-15 and 18-20, drawn to a method of controlling insects via Protein A, Protein B, and Protein C, classified in class 514, subclass 2.
- II. Claims 16 and 17, drawn to transgenic plant expressing Protein A, Protein B, and Protein C, classified in class 800, subclass 295.

Applicant must also elect one sequence for each of Protein A, Protein B, and Protein C for Examination. This is not a species election, but an election of a patentably distinct invention because each of the sequences of Protein A, for example, has a different structure. For example, SEQ ID NO: 14 has an N-terminal sequence of : Met Ile, Lys Val Asn Glu Leu Leu Asp Lys and SEQ ID NO: 21 (which is actually a DNA sequence) has an N-terminal sequence of: Met Asn Glu Ser Val Lys Glu Ile Pro Asp. Thus, Claim 1(ii), for example, represents an improper Markush group. Further, 420 different combinations of Protein A, B, and C are encompassed by the method.

The list of sequences from which Applicants will elect a single sequence for Protein A are:
SEQ ID NOs: 14, 21, 34, 59, 62, and 63.

The list of sequences from which Applicants will elect a single sequence for Protein B are:
SEQ ID NOs: 18, 22, 40, 45, 49, 56, and 60.

The list of sequences from which Applicants will elect a single sequence for Protein C are:
SEQ ID NOs: 16, 25, 42, 43, 47, 51, 57, 58, 61, and 64.

As noted above, SEQ ID NO: 21 represents a nucleic acid sequence and not an amino acid sequence. Applicants may wish to check their SEQ ID NOs to insure that appropriate amino acid sequences are being claimed, and searched upon examination. The sequence

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listing is 276 pages long, and it would be best if Applicants corrected any sequence mishaps prior to examination.

The inventions are distinct, each from the other because of the following reasons:

The method of controlling insects by contacting them with Protein A, B, and C as set forth in Invention I does not utilize the transgenic plant of Invention II. Therefore, Inventions I and II are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Karen Cochrane Carlson Ph.D." with a stylized flourish at the end.

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER